Docket No.: 50107-408   PATENT
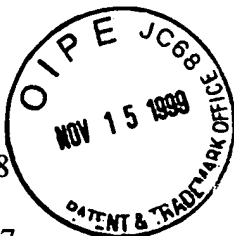
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of   : RESPONSE UNDER 37 CFR 1.116
                                                  : __EXPEDITED PROCEDURE__
David Simpson, et al.   :

Serial No.: 08/948,328   : Group Art Unit: 2742
                                                  :
Filed: October 10, 1997   : Examiner: A. Hoosain
                                                  :
For:PERSONAL NETWORK NEWSCASTER WITH ENHANCED TEXT TO SPEECH
    SYNTHESIS

DECLARATION UNDER 37 C.F.R. 1.132

Honorable Commissioner of
 Patents and Trademarks
Washington, D. C. 20231

Sir:

1.   I, David L. Stewart, am a partner with the firm of McDermott, Will & Emery,

specializing in areas of telecommunications, networks, computer hardware and computer software.

A copy of my *curriculum vitae* is attached.   From that you can see that my experience includes

serving as Chief Petitions Examiner and as a Patent Judge at the Board of Patent Appeals and

Interferences (1989-1993).   During that period, I authored several decisions on review of final

Office Actions in appealed applications involving the above-identified fields of technology. My CV

also shows that my educational background includes completion of course work for a PhD in

Information Technology.

2.   I have read the Office Action, dated September 17, 1999, issued in the above-identified

application, with particular focus on the characterization therein of the teachings of U.S. patent

5,572,643 to Judson. Page 3 of the Office Action specifically attributes claimed functionality to Judson as follows:

> (b) performing a significant portion of a text to speech process to convert the textual information of at least one of the messages to aural (speech synthesizer) instructions over the data communication network (Col. 6, lines 25-44), and
> (c) transmitting the aural (speech synthesizer) instructions over the data communication network (Col. 6, lines 28-35);
> and
> a subscriber terminal, 12, for receiving the aural (speech synthesizer) instructions via the data communication network, said subscriber terminal, 12, comprising an inherent speech synthesizer for synthesizing an aural information object (speech waveform signal) representing the at least one message form the aural (speech synthesizer) instructions (col. 6, lines 1-12 and 32-35).

A similar description of Judson appears at pages 7 and 8 of the Office Action.

3. I have carefully studied the cited Judson patent with particular emphasis on those portions to which reference is made in the Office Action. It is my opinion that the Judson patent does not disclose or teach (1) conversion of text to speech, (2) speech synthesis, (3) transmission of speech synthesis instructions, nor does Judson (4) imply that the "subscriber terminal" inherently includes a speech synthesizer.

4. The Judson patent describes placement of an information object within a comment tag of a web page. The web page is displayed at user's monitor without the information object, the latter being stored in a temporary file. Upon activation by the user of a hypertext link in the displayed web page, the browser displays the information object during the period in which the browser obtains downloading of the hypertext document from a remote server. Judson states that the information object need not be merely a visual output, but that some or all parts "can be conveyed to the user aurally (via a multimedia speaker set, for example) as well as on the display screen." No detailed description has been provided of this "aural" conveyance.

5. It is my opinion that a person of ordinary skill in the art would not have taken Judson's example of an information object used to produce a sound output from the user's speaker as a disclosure of speech synthesis, let alone a more specific text to speech synthesis application. An artisan finding a teaching in Judson of transmission of speech synthesis instructions over the data communication network is an even more unlikely possibility.

6. It is my opinion that a person of ordinary skill in the art would have interpreted the Judson patent disclosure to teach that, for conveyance of the "aural" portion of the information object, a digitized audio signal waveform, possibly in compressed format, such as a *.wav file would be included in the conveyed information object data.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing therefrom.

Date_____11/10/99_____

David L. Stewart_____

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I. EDUCATION

A. B.S. Physics, with honors, 1967, from California State University at Los Angeles.
B. Juris Doctor, with honors, 1974, from George Washington University in the District of Columbia.
C. PhD candidate, George Mason University, Fairfax, Virginia, in Information Technology.

II. EXPERIENCE SUMMARY

A. 1993-Present: Partner: McDermott, Will & Emery (absorbed Lowe, Price, LeBlanc & Becker).
B. 1989-1993: Administrative Patent Judge (Examiner-in-Chief) Board of Patent Appeals and Interferences, United States Patent and Trademark Office (PTO).
C. 1985-1989: Special Assistant to the Assistant Commissioner for Patents and concurrently Director of Systems Modelling and Advanced Studies in the Office of the Assistant Commissioner for Information Systems, PTO.
D. 1981-1984: Chief Petitions Examiner, PTO.
E. 1968-1981: Patent Examiner in Group 230, PTO. Multiplexed Communications Systems.

III. MISCELLANEOUS.

A. Deputy Head of Delegation--Negotiations with Japanese and European Patent Offices, Tokyo, 1988.
B. Chief Negotiator for Examiner's Performance Appraisal System.
C. Communications Engineer--Viet Nam.
D. Bronze star for service in Viet Nam.
E. Detail, Office of Enrollment & Discipline
F. Publications:
   1. "Patenting of Software...," Journal of Patent & Trademark Office Society, September, 1995, p. 681.
   2. Ex parte Dash, 27 USPQ2d 1481 (BPAI, 1993).
   3. Ex parte Veldhuis, 44 PCTJ 486 (September 17, 1992).